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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,681	11/28/2001	Stefan Berndt	112740-351	4573
29177	7590	01/14/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC			PEACHES, RANDY	
P. O. BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	
			2686	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/997,681

Applicant(s)

BERNDT ET AL.

Examiner

Randy Peaches

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 6-9 is/are rejected.
- 7) ☒ Claim(s) 4, 8 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

**Claims 4, 8 and 9** are objected to because of the following informalities:

The Examiner would like to bring to the Applicant's attention that the claimed language "**actual availability-information**" is inconsistent with the disclosed language represented in the Specification. The Applicant uses the word "**actual**" in the claimed language, which is not clearly disclosed or represented in the Specification. The Examiner concludes that the claimed representation constitutes "*new matter*". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 2-4 and 6-9** are rejected under 35 U.S.C. 102(e) as being anticipated by Owens et al (U.S. Patent Number 6,633,630 B1).

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Regarding **claim 2**, according to **claim 8**, Owens et al teaches in FIGURE 1, columns 7 and 10 lines 6-10, 31-34 lines 3-17, respectively, wherein the forwarding messages intended for the forwarding subscriber further comprises:

- A message repository, which read on claimed "storage device", for temporarily storing at least one of the **message** received via the at least one telecommunication interface and **the** converted message.

Regarding **claim 3**, according to **claim 8**, Owens et al teaches in column 10 lines 35-55, wherein the subscriber related information of the database contains an information element which identifies the terminals to be selected.

Regarding **claim 4**, according to **claim 3**, Owens et al teaches in column 12 lines 31-50, wherein the said communication server (28) changes the information element based on the messages sent off by the relevant forwarded-to subscriber, which contains the information **relating to an availability of the forwarded-to subscriber**. Additionally, as stated in column 12 lines 49-50, Owens et al discloses that if a receiver cannot be located, the sender maybe placed into the voicemail. The receiver can maintain rules for the incoming messages as well. See column 12 lines 25-26.

Regarding **claim 6**, according to **claim 9**, Owens et al discloses in columns 7 and 10 lines 6-10, 31-34 lines 13-17, respectively, a method further comprising:

- storing, temporarily, the at least one message on a storage device in at ***least one of the step of receiving and the step of converting.***

Regarding ***claim 7***, according to ***claim 9***, Owens et al discloses in column 10 lines 49-56, a method wherein during the step of selecting, a selection is made based on an information element which is contained in the subscriber-related information and which identifies the terminals to be selected.

Regarding ***claim 8***, Owens et al discloses a telecommunication device for forwarding messages for a forwarded-to subscriber, comprising:

- A communication server (28), which reads on claimed "control device";
- A database for storing subscriber related information, ***the subscriber related information identifying a plurality of terminals associated with the forward-to subscribers, a plurality of message formats compatible with the terminals; (see FIGURE 1, column 3 lines 24-40) and contains the information relating to an availability of the forwarded-to subscriber associated with the terminal.***
- At least on telecommunication network interface via which messages can be exchanged with the telecommunications network. See column 7 lines 4-10; and
- At least one conversion module for converting temporarily stored messages into at least one of the message formats identified by the subscriber-related information and in the stored database. See columns 2 and 8 lines 55-57 lines 39-47.

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- Wherein the said communication server (28) selects, upon receipt of a message intended for a forwarded-to subscriber, at least one of the **plurality** terminals via which the forwarded-to subscriber can be reached **based on the actual availability of the forwarded-to subscriber associated with the terminal (see column 12 lines 31-50)**, and at least one message format compatible with the at least one message terminal, via the subscriber related information, supplies the message to the at least one conversion module (see column 7 lines 34-37), depending upon the message format selected and receives the messages converted by the at least one conversion module and forwards them to the telecommunication network interface respectively corresponding to the relevant message format for transmission to the at least on selected terminal. See column 7 lines 24-50.

Regarding **claim 9**, Owens et al discloses in column 2 lines 23-57, a method for forwarding a message intended for a forwarded-to subscriber, effected via a telecommunication device, the method comprising the steps of:

- receiving the message (column 2 lines 33-36);
- selecting at least one of **plurality** of terminal via which the forwarded-to subscriber can be reached (column 7 lines 22-24), and selecting at least one message format, which is compatible with the at least one of **plurality** terminal, via subscriber-related information (column 7 lines 37-40);
- converting a temporarily stored message into the at least one message format selected (column 7 lines 41-43); and

- transmitting the converted message to the at least one terminal selected via a telecommunication network respectively corresponding to the relevant message format (columns 3 and 7 lines 24-25 lines 41-47, respectively).

### ***Response to Arguments***

Applicant's arguments filed 08/06/2004 have been fully considered but they are not persuasive.

Regarding the Applicant's argument deemed toward the insufficient support of the Examiner's reference Owens et al. (U.S. Patent Number 6,633,630 B1). The Examiner concludes that the Applicant's argument of the actual-availability information of the forwarded to subscriber does not place the application in a condition of allowance and further does not change the scope of the originally filed claimed language. Owens clearly teaches in column 12 lines 31-50 of the determination of the locale of the said receiver is pertinent in the successful transfer of the said message. In reference to the added term "actual", the Examiner interprets the language as the "potential" of an individual to be available. Meaning that, although one might be "available" at a location physically, but not available to talk to another; yet, the "actual-availability" of that individual is only apparent when he/she is ready to receive a message, whether being voicemail or fax. In addition, per the above rejection, the amended language is not persuasive.

Per the above rejection of newly added ***claim 9***, Owens clearly teaches of transmitting the converted message to the at least one terminal selected via a telecommunication network. Further, Owens does suggest in column 12 lines 31-50, where messages are sent based on availability (locale).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (703) 305-8993. The examiner can normally be reached on Monday - Friday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches  
December 23, 2004

*Marsha D Banks-Harold*  
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